

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1-10 and 15-18 are pending in the present application. Independent claim 1 remains unchanged. At this time, applicants note with appreciation the indication that claim 8 is allowed. Claims 13 and 14 have been rewritten in independent form to include all of the recitations of their base claim. As a result, applicants believe that claims 13 and 14 are also now allowable. New claims 15-18 have been added. Support for new claims 15-18 may be found in claims 1-5.

In the outstanding Official Action, claims 1, 2, 9, 10 and 12 were rejected under 35 USC 102(b) as allegedly being unpatentable over GASMENA. Claims 3-5 were rejected under 35 USC 103(a) as allegedly being unpatentable over GASMENA in view of EKLUND et al. Claims 3, 4, 6 and 7 were rejected under 35 USC 103(a) as allegedly being unpatentable over GASMENA in view of IWAMURA et al. These rejections are respectfully traversed.

At this time, the Examiner is respectfully reminded that claim 1 recites the transitional phrase "consisting essentially of". The transitional phrase "consisting essentially of" indicates that the scope of the claim includes the recited materials or step "and those that do not materially affect the

basic and novel characteristics" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Applicants respectfully submit that the silicone-containing polyether relied upon by GASMENA materially affects the basic and novel characteristics of the claimed invention.

The specification teaches that the claimed compositions provide a number of advantages over existing epoxy-resin-based compositions (see page 6, lines 15-29). Indeed, applicants submitted a declaration with the response of January 24, 2005 that demonstrates that when the silicone-containing polyether used by GASMENA is left out of the composition, a significantly improved gloss retention and a lower color difference are achieved. Thus, the declaration provides further evidence that the GASMENA composition is distinct from that of the present invention in that it is essential that the GASMENA composition includes silicon-containing polyether materials.

While the Office Action contends that the declaration does not distinguish the full scope of the claims, the Patent Office provides no evidence to support this position or to contradict the showings of the declaration. Indeed, applicants believe that the Patent Office disregards the showing in the declaration that the color difference with GASMENA is quite different for compositions with and without the silicon containing polyether, indicating that the silicon containing

polyether plainly affects the "material characteristics" of the invention.

Thus, in view of the above, applicants believe that GASMENA fails to anticipate claims 1-10 and 12-14.

At this time, applicants note that claims 15-18 have also been added. Independent claim 15 is directed to a composition that comprises the resin constituent recited in independent claim 1. The claim recites that the weight ratio between the epoxy silane, polysiloxane and non-aromatic epoxy resin is 1:2-5:2-5. GASMENA fails to disclose or suggest the claimed invention. Applicants also note that while the Office Action notes that amounts in the declaration vary to a small degree from the recited ratio, the amounts clearly coincide with those found in Table 1. As GASMENA fails to provide any recognition of the claimed ratio, applicants believe that GASMENA fails to anticipate or render obvious the claimed invention.

As the Examiner is aware, a particular parameter or variable must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the parameter or variable might be characterized as routine or obvious. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Thus, as GASMENA fails to disclose or suggest such a ratio, applicants believe that GASMENA fails to anticipate or render obvious the claimed invention.

As to the EKLUND and IWAMURA et al. publications, applicants believe that they fail to remedy the deficiencies of GASMENA. Neither publication discloses nor suggests the composition that lacks a silicon-containing polyether or suggests the recited ratio as set forth in claim 15. As a result, applicants believe that GASMENA, EKLUND et al., and IWAMURA et al., alone or in combination with each other, fail to anticipate or render obvious the claimed invention.

In view of the present amendment and foregoing Remarks, therefore, applicants believe that the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

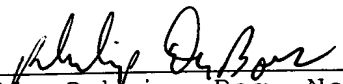
Charge the fee of \$200 for the two independent claims added herewith to deposit account No. 25-0120.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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